

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Sho Kuwamoto, et al.	Art Unit :	2195
Patent No. :	7,480,910	Examiner :	Kenneth Tang
Issue Date :	January 20, 2009	Conf. No. :	6894
Serial No. :	09/875,549		
Filed :	June 6, 2001		
Title :	SYSTEM AND METHOD FOR PROVIDING INFORMATION AND ASSOCIATING INFORMATION		

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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 512 to 882 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008, 580 FSupp2d 138; 88 USPQ2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under

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35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before August 6, 2002 (the date that is fourteen months after June 6, 2001, the date on which the application was filed). The PTO mailed the first non-final Office Action on August 3, 2004, thereby according a PTO Delay of 728 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from August 7, 2002 (the day after the date that is fourteen months after the date on which the application was filed), to August 3, 2004. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 728 days.

“B Delay”

The period beginning on June 7, 2004 (the day after the date that is three years after the date on which the application was filed), and ending January 20, 2009 (the date the patent was issued), is 1,689 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Request for Continued Examination. In the present application, a Notice of Appeal was filed on August 8, 2005, and a Request for Continued Examination was received by the PTO on October 11, 2005, which

resulted in a period of 64 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a first Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, the first Request for Continued Examination was filed on October 11, 2005, and the patent issued on January 20, 2009, which resulted in a period of 1197 days that must also be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

"B Delay" for this patent is therefore calculated as 1,689 days minus 64 days minus 1197 days, for a total of 428 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 428 days.

Overlap of "A Delay" and "B Delay"

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 64 days, from June 7, 2004, to August 3, 2004.

Applicant Delay

A reply to an Office Action was due on or before November 3, 2004 (the date that is three months after August 3, 2004, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on January 7, 2005, thereby according an Applicant Delay of 65 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from November 4, 2004 (the day after the date that is three months after the date on which the Office Action was mailed), to January 7, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before July 6, 2005 (the date that is three months after April 6, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on August 8, 2005, thereby according an Applicant Delay of

33 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from July 7, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to August 8, 2005. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before May 8, 2006 (the date that is three months after February 8, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on June 8, 2006, thereby according an Applicant Delay of 31 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from May 9, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to June 8, 2006. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on August 3, 2006, subsequent to a reply filed on June 8, 2006. Patentee was accorded a delay of 56 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from August 4, 2006 to June 8, 2006. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before March 11, 2007 (the date that is three months after December 11, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on April 11, 2007, thereby according an Applicant Delay of 31 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from March 12, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to April 11, 2007. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 216 days (i.e., the sum of 65 days, 33 days, 31 days, 56 days, and 31 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 512 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,098 days (i.e., the sum of 728 days of "A Delay" and 428 days of "B Delay" minus the 58 days of overlap);
- 2) Total Applicant Delay should be calculated as 216 days; and
- 3) Total PTA should be calculated as 882 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0731001.

Respectfully submitted,

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